

Application No. 09/557,196
Amendment "I" dated December 22, 2005
Reply to Office Action mailed November 7, 2005

REMARKS

The Office Action mailed November 7, 2005, considered and rejected claims 1-19. Claims 1-7 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description and enablement requirements. Claims 1-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtz (U.S. Patent No. 5,574,440), in view of Macrao et al. (U.S. Patent No. 6,745,391).¹ By this action, independent claims 1 and 5 have been amended, no claims have been cancelled, such that claims 1-19 remaining pending for examination.

Reconsideration of the application is respectfully requested in view of the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references.

Rejections under 35 U.S.C. 112, first paragraph

Sections 2-4 of the Office Action reject claims 1-7 under 35 U.S.C. 112, first paragraph, as both failing to comply with the written description requirement, and as failing to comply with the enablement requirement. Applicant notes that independent claims 1 and 5 have been amended to remove the phrase "allow the central device to automatically" that was added to the claims in the last action. Accordingly, Applicant believes that this amendment has overcome the 35 U.S.C. 112, first paragraph rejection. Applicant further notes that claims 1 and 5 as now constituted are sufficiently described and enabled as required by 35 U.S.C. 112 by page 21, lines 11-22 of the specification.

¹ Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, inasmuch as it is not necessary following the amendments and remarks made herein, which distinguish the claims from the art of record, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last office action, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

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Rejections under 35 U.S.C. 103(a)

Sections 5 and 6 of the Office Action reject claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over Kurtz in view of Macrae et al. As an initial matter, Applicant respectfully notes that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate, *inter alia*, that the prior art references when combined: teach or suggest all the claim limitations and have some suggestion or motivation to combine. MPEP §2143. Applicant respectfully asserts that in this case a *prima facie* case of obviousness is not met for at least the reasons that will now be explained.

Claim 1 is directed to a method for using a central management device to tune to channels that are requested by a user for display on a display device. The method includes receiving user input at the central device selecting a channel to be tuned to. It is then determined, using electronic programming guide data stored at the central device, whether the signal is scrambled or not. If the signal is scrambled, it is routed from the central device to a descrambler where it is descrambled and tuned for display. If the signal is not scrambled, a tuner internal to the central device is used to tune the channel for display. Accordingly, the scrambled and the non-scrambled signals need to be tuned prior to being displayed.

Claim 5 is directed to a corresponding computer program product for implementing the method of claim 1. Claim 8 is directed to a correspondingly similar apparatus for implementing the method of claim 1.

Even if the combination of Kurtz and Macrae is appropriate (which the applicants do not concede for at the reasons provided further below), the combination of Kurtz and Macrae, do not teach or suggest every limitation as recited by claim 1. Kurtz is generally directed to a switching apparatus for enabling a user to control and recognize whether the programming is coming over a first source that includes signals that have been passed through a cable box thereby descrambling any previously scrambled signals from that first source, or whether the programming is coming over a second source that has not been passed through a cable box and thus may contain a scrambled signal. The Examiner, nevertheless, relies on Kurtz for showing a system that determines whether a signal is scrambled or non-scrambled and, based on this determination, sending the signals to a descrambler or retaining the signal in the central device (Office Action pages 4-5). Kurtz, however, does not teach or suggest such a system.

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In fact, as mentioned in several places in Kurtz, integral to the switching mechanism is a two way RF power splitter that takes a single RF input signal, splits the input signal, and then automatically provides a portion of the split input signal to a cable converter box. This portion then becomes one signal source for the switching apparatus when returned to the switching apparatus from the cable converter box. The portion of the split input signal not provided to the cable converter box becomes a second signal source for the switching mechanism. (See column 3, lines 50-55, column 5, lines 20-65, and column 10, lines 20-35). Nowhere, however, does Kurtz disclose that the splitter or any other mechanism or user determines whether a signal is scrambled and unscrambled before the splitter routes portions of the split input signal to the cable converter box for descrambling. Such a determination is typically well beyond the capabilities of conventional splitters in any case. In stark contrast, claim 1 recites that a determination is made prior to routing any scrambled signals to a descrambler.

Moreover, Kurtz in several places discloses that the portion of the split input signal that is provided to the cable converter box is provided to the cable converter box regardless of whether the input signal has scrambled content or not. Thus, there is no need for a determination to be made of whether or not the signal is scrambled prior to sending the signal to the descrambler if, in fact, a portion of the single input signal is going to be automatically sent to the descrambler in any case.

A further example illustrates this point with even stronger language. Column 5, lines 22-50 discloses the various connectors of apparatus 10. This section of Kurtz discloses connector 25 as "potentially" having a scrambled signal at the cable converter box (line 36-37). Further, this section at lines 43-46 states "[t]he labeling thus far reveals that the apparatus 10 includes a splitter function splitting the incoming cable signal to drive two sources, i.e., that introduced to the converter box, and that at the output of the converter box." Again, nowhere in this section is it indicated that the splitter or any other mechanism or user makes any determination prior to descrambling. The splitter simply splits the signal and provides a portion to the cable converter box, where a potentially scrambled signal element may be descrambled. The signal is only "potentially" scrambled because the signal provided to the splitter is also only potentially scrambled. There is no determination disclosed regarding whether or not the signal is scrambled prior to being sent to the descrambler. Even non-scrambled signals are sent in the split portion to the descrambler.

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In addition, the schematic Figures 5 -8 of Kurtz also support the argument that no determination is made before sending a portion of the signal to the cable box. All of these figures and their accompanying descriptions illustrate that the splitter is taking an input signal and then providing a portion to the cable converter box as has been described. For example, column 10, lines 19-27 states "The arrangement of FIG. 5 initially provides for the selection of source A as at line 170, for example representing a non-premium cable input. This source, as described above, may be split by a two-way RF power splitter as represented generally at 171, to provide an input to a cable converter box via line 172. The output of that cable converter box then may become a second source or source B, the input of which is represented at line 174." The figures and their accompanying descriptions, however, in no way teach or suggest a determination of a scrambled signal before sending the portion to the converter. A splitter is typically just a piece of hardware that provides identical signals on two different paths. No intelligence decision making is typically performed.

These examples just cited are in stark contrast to the required elements of claim 1. As mentioned, claim 1 recites that the determination of whether the signal is scrambled or not prior to the signal being routed to the descrambler. Accordingly, since Kurtz does not disclose making a determination of a scrambled signal prior to routing a portion of the signal to the cable converter box, Kurtz does not contain all of the required elements of claim 1.

Nevertheless, even assuming for arguments sake that the Kurtz does teach or disclose a system that determines at a central device whether a signal is scrambled or non-scrambled and, based on that determination, sending the scrambled signal to a descrambler, Kurtz does not disclose making the determination using electronic programming guide (EPG) data as required by claim 1. The Examiner, however, uses Macrae for the general proposition that an EPG can be used to detect whether a signal is scrambled or not. However, Macrae actually fails to teach or show any system or method in which the EPG data is used to determine whether a signal is scrambled or not. Instead, Macrae is directed to a system that, upon determining that a scrambled signal is no longer scrambled, updates an EPG to reflect the change in a scrambled signal becoming non-scrambled. (Column 1, lines 54-65). For example, if HBO does a promotional to allow everyone to view their product, the user may not be aware of this. (Column 1, lines 37-43). Macrae provides a way for reflecting this changed status to a user through an EPG. However, it is not the EPG that makes this determination. Instead, this determination is

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made by special detectors (Column 11, lines 17-20) and software applications (Column 3, lines 25-27) or from directly received information (Column 11, lines 35-38). It is then, only after first determining whether a signal is scrambled or not, that the EPG is updated to reflect that a scrambled signal is now no longer scrambled. (Column 11, lines 20-25; Column 1, line 64-Column 2, line 1).

The reversal of this causation is significant, since it removes any motivation whatsoever to modify Macrae to teach the use of electronic program guide to make the determination of the signal being scrambled or not. As the determination is already made independent of the electronic program guide, there would be no need to use the data from the electronic program guide to make that determination. Furthermore, there is no teaching in Macrae that the use of the electronic program guide data would make the determination any more beneficial. If the rejection is to be continued, the Applicant respectfully requests clarification on where Macrae teaches that the electronic program guide data facilitates the determination on whether or not the signal is scrambled, rather than simply updating the electronic program guide in response to the determination of whether the signal is scrambled or not.

In addition, Applicant notes that Kurtz contains no motivation or suggestion to combine with Macrae. As mentioned previously, Kurtz explicitly states that the two-way splitter is an "integral part" of the invention. In addition, the splitter is shown in the schematic figures as being necessary to the overall apparatus as described in Kurtz. The splitter splits the input signal to help provide the required two signal sources. However, the use of EPG data to determine whether or not a signal should be sent to the cable converter box would destroy the utility of the splitter as described in Kurtz. It is highly doubtful that a reference would teach a combination that would remove the utility of an integral part. As mentioned above, the prior art must show some suggestion or motivation to combine in order for the Examiner to make a *prima facie* case of obviousness. Accordingly, there is no motivation to combine the references for at least those reasons disclosed above.

Even assuming for arguments sake only, and not to concede the point, that there is a motivation or suggestion to combine, the combination of Kurtz and Macrae also fails to teach or suggest that a non-scrambled signal is tuned by a tuner internal to a central device. Kurtz, contrary to the assertion on page 5 of the Office Action, does not disclose using an internal tuner that is located at the central device to tune non-scrambled signals for display. In fact, Kurtz only

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mentions having access to an external TV tuner or a VCR tuner. For example, schematic figure 8 shows a connection 26 and a connection 24 that have attached shunt inductors 282 and 300 respectively. Column 14, lines 14-15 and lines 50-53 disclose that the shunt inductors serve to shunt stray low frequency voltages emanating from a TV tuner at connector 26 and a VCR tuner at connector 24. These inductors protect the switching apparatus from voltages produced by external TV and VCR tuners. Thus, Kurtz by the very inclusion of this circuitry implies that the switching apparatus does not include an internal tuner. This contention is strengthened by the fact that Kurtz does not mention a tuner, internal or external, in any other place in the reference. Accordingly, the combination fails to disclose using an internal tuner that is located at the central device to tune non-scrambled signals for display as required by claim 1.

For the foregoing reasons, the combination of Kurtz and Macrae does not disclose every element of claim 1 or suggest or teach a motivation to combine. Accordingly, the Examiner has failed to make a *prima facie* case of obviousness. Independent claims 5 and 8 have elements similar to those discussed above with regard to claim 1. Accordingly the combination of Kurtz and Macrae does not disclose every element of independent claims 5 and 8 for at least those reasons stated above with regard to claim 1. In addition, since the pending dependent claims variously depend from independent claims 1, 5, and 8, the combination of Kurtz and Macrae does disclose every element of the dependent claims for at least those reasons stated above with regard to claim 1.

Based on at least the foregoing reasons, therefore, Applicant respectfully submit that the cited prior art fails to make obvious Applicant's invention, as claimed for example, in independent claims 1, 5, and 8. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertion with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in the future if necessary or desirable, and Applicants reserve the right to do so. Applicant therefore respectfully requests all rejections be removed and that this case be allowed in a prompt manner.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

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Dated this 22nd day of December, 2005.

Respectfully submitted,



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